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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,521	10/26/2001	Stephen J. Sharp	086402-9020-00	3137
23585	7590	01/14/2004	EXAMINER	
MICHAEL BEST & FRIEDRICH LLP 3773 CORPORATE PARKWAY SUITE 360 CENTER VALLEY, PA 18034-8217			LIU, HAN L	
		ART UNIT	PAPER NUMBER	
		3746		
DATE MAILED: 01/14/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/045,521	SHARP ET AL. <i>10</i>
	Examiner	Art Unit
	Han Lieh Liu	3746 <i>10</i>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 31 October 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 23-27 and 30-41 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 23-25,27,30,32,34 and 35 is/are rejected.
- 7) Claim(s) 26,31,33 and 36-41 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 31 October 2003 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

1. Receipt is acknowledged of papers submitted for "Amendment" on 10/31/2003. This amendment amends claims 23 – 26, 30 and 32. Amendment papers have been placed of record in the file. The amended claims are examined in this office action.

Priority

2. The status of nonprovisional parent application(s) (Application 09/777210) has been updated. Parent application has become a patent, the expression "now Patent No. 6447264" should follow the filing date of the parent application in the Specification.

Drawings

3. Receipt is acknowledged of Formal Drawings submitted on 10/31/2003 where correction is made on duplicated legend "88" in Fig. 4.

It is, however, not clear if legend "26" in Fig. 3 is pointing to the interior of the compartment or the "rear wall" as exemplified in Fig. 4.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 32 and 35 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 11 of U.S. Patent No. 6447264 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between the patented claim and the proposed application claim is minor and obvious from each other. The instant claim 32 includes the structural element partition and identifies flow passages. However, the patented claim 11 discloses compartments, which is considered having walls as partition that defines the compartments and various flow passages. In the instant claim 32, the structure element, i.e. partition, and flow passages in claim 35 are included in the patented claim 11. Any infringement over the patent would also infringe over the instant claim. Hence, the instant claim does not differ from the scope of the patented claim 11.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 23 – 25 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Mueller (USPN 4359085).

With regard to claim 23, Mueller discloses an air compressor unit in Figs. 1 – 3, comprising: multiple compartments (8, 9 and 10) within the air compressor unit (1) including at least first (9) and second (8) compartments; an air compressor (7) disposed in the first compartment (9) and a motor (not labeled) disposed within the second compartment (8) that drives the a fan (6); a blower (32, shown in Fig. 3) draws air into the unit and generates an air flow through the unit (indicated with flow arrows); an intake port (18) entering the unit (1); a discharge aperture (19) existing the unit; wherein the multiple components are configured such that a single initial air flow enters the unit from intake port (18), the multiple compartments divide the initial air flow (10 and 25) into first and second distinct (26 and 27) intermediate air flows with the first intermediate air flow (26) flowing through the first compartment (9) and the second intermediate air flow (27) flowing through the second compartment (8), the distinct intermediate air flows converge to a single final flow through port (31) that exists the unit through the discharge aperture (19).

With regard to claims 24 – 25 and 27, Mueller discloses the invention as claimed in base claim 23. Furthermore, Mueller discloses that the multiple compartments includes an intake compartment (10 and 25), the first compartment (9) and a discharge compartment (28, 29); wherein the intake port (18) is in fluid flow communication with the intake compartment (10, 25) and the initial air flow enters the intake compartment through the air intake port (18); wherein the discharge aperture (19) is in fluid flow communication with the discharge compartment (28 and 29), and the final air flow exists the discharge compartment through the discharge aperture.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller (USPN 4359085) as applied to claim 23 above, and further in view of Kubo et al. (USPN 5507618).

Mueller discloses the invention substantially as claimed in base claim 23. Mueller, however, does not disclose to have an after-cooler to be disposed between the first compartment and the discharge compartment. Kubo et al. disclose that the after-cooler (63) being disposed within the enclosure and between the compressor (3) and discharge aperture (41). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to advantageously provide Muller's compressor with an after-cooler to control the discharge temperature and improve compressor efficiency as illustrated by Kubo et al.

7. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller (USPN 4359085) as applied to claim 23 above, and further in view of Nichols et al. (USPN 5127808).

Mueller discloses the invention substantially as claimed in base claim 23. Mueller, however, does not specifically disclose the compressor (7) is a reciprocating compressor. Nichols et al. teach that it is well known that an air compressor includes a reciprocating piston type, column 3 lines 8 – 10. Therefore, it would have been obvious to one having ordinary skill in the

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art at the time the invention was made to advantageously employ a reciprocating compressor for its commonly available and relatively easier in maintenance.

Allowable Subject Matter

8. Claims 26, 31, 33 and 36 – 41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Amendment

9. The amendment to the Office Action mailed on 07/29/2003, for claims 23 – 27 and 30, has been reexamined and determined that the amendments are not persuasive. The examiner apologizes the indication of allowable subject matters in the earlier interviews, which may have caused the inconvenience in the amendment, received on 10/31/2003.

The indicated allowability of claims 35 – 41 are withdrawn in view of the re-examination of reference(s) to Lucas et al. (USPN 6447264 B1) for double patenting. Rejection based on the newly re-examined reference(s) is presented above in paragraph 3.

This Office Action is non-final to afford the applicant the opportunity to respond to the new ground of rejection.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Han Lieh Liu whose telephone number is 703-305-0860. The examiner can normally be reached on Monday - Thursday 7:30 to 16:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on 703-308-2675. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-0861.



Han Lieh Liu

January 9, 2004



JUSTINE R. YU
PRIMARY EXAMINER

